

§103(a) as being obvious and unpatentable over Proudfit (U.S. Patent No. 5,314,187) was issued by the Examiner on September 23, 1998. In that Office Action, the Examiner maintained the following:

"Proudfit discloses the claimed invention with the exception of the particular hardness/specific gravity claimed. However, Proudfit discloses a hard inner cover and softer outer cover formed from materials such as those disclosed by the applicant. Obviously, the exact hardness of the layers would have been up to the ordinary skilled artisan depending on the distance and feel considerations. Absent a showing of unexpected results, the particular parameters of Proudfit's ball, which is formed from the same materials in the same fashion claimed by applicant, would have been obvious to one of ordinary skill in the art."

Applicant has previously argued to the U.S. Patent and Trademark Office that the Proudfit '187 patent can easily be distinguished from the multi-layer golf balls of the present patent application in that Proudfit requires the use of rubber-based elastomers in the outer cover layer. (See response filed March 23, 1999).

However, notwithstanding the above, Applicant also recently noted that the Proudfit reference can be removed as a valid prior art reference through the submission of a Declaration under 37 C.F.R. §1.131. More particularly, while the Proudfit application which resulted the '187 patent was filed on June 29, 1992, it was previously believed that the effective filing date of the subject matter of this application dated back to July 26, 1991. This is a result of the fact that the application filed June 29, 1992 was a continuation-in-part of an original parent application (i.e. Serial No. 733,789) that was filed on July 26, 1991 and subsequently abandoned.

However, upon review of the file wrapper history of Proudfit parent application Serial No. 733,789 (filed July 26, 1991), it became apparent that the subject matter concerning multi-layer covers now being relied upon by the Examiner in his outstanding rejection was actually introduced into the second Proudfit application, Serial No. 905,895, filed on June 29, 1992. The filing date of the second or C-I-P application is less

than one year prior to the effective filing date of the present application of June 1, 1993 and it is long after Applicant's invention date.

As a result, the effective filing date for the Proudfit ('187), insofar as Proudfit is being relied upon by the Examiner, is June 29, 1992. This is less than one year prior to the effective filing date of the present application. Hence, Applicant can now establish, through the enclosed Declaration under 37 C.F.R. §1.131, that Applicant had reduced the invention of the present application to practice prior to the effective filing date of Proudfit ('187) of June 29, 1992.

Along these lines, 37 C.F.R. §1.131 allows the removal of a reference as prior art through the submission of an Affidavit or Declaration showing that the applicant had previously reduced the invention to practice before the effective filing date of the application which resulted in the prior art reference if the prior art reference has an effective filing date of less than one year prior to the filing date of the pending application. If this occurs, the reference can be removed as prior art by the Applicant showing that he or she had already actually reduced the invention to practice in the U.S. before the filing date of the referenced patent.

In view of the above, Applicant now submits in the attached Declaration under 37 C.F.R. §1.131, that he (Michael J. Sullivan) invented the subject matter sought to be patented prior to the effective filing date of Proudfit ('187) of June 29, 1992. In support thereof, Applicant has attached to the enclosed Declaration, evidence which supports the declarative statement that the invention disclosed in the present application was completed prior to June 29, 1992.

Specifically, Table 1 of the attached Declaration is the same as that shown in the present application as Table 7. See pages 41 and 42 of the present specification. The only difference between attached Table 1 and Table 7 of the application is that Table 1 uses reference numbers "61-1" to "61-5" to identify examples while Table 7 uses reference letters "A" - "E". As it is noted in the specification, compositions "A" (61-1), "B" (61-2) and "C" (61-3) are for high acid intermediate balls of the invention of the present application. Composition "D" (61-4) is a hard, low acid intermediate ball.

Likewise, Table 2 of the attached Declaration is also replicated in the present application, in part, by Table 8, as shown on page 44 of the present application's specification. As can be seen from Table 2, example 1 utilizes the Table 1 intermediate

ball 61-1 (ball A from Table 7), example 2 utilizes the Table 1 intermediate ball 61-2 (ball B from Table 7) and example 3 utilizes the Table 1 intermediate ball 61-3 (ball C from Table 7). As indicated previously, cores A, B, and C from Table 7 (61-1 to 61-3 from Table 1) are in accordance with the present invention. In addition, cover TE-90, utilized in Examples 1-3 of Table 2 attached hereto and Table 8 of the application, is described as formulation "B" on attached Table 2 and on page 43, lines 14-18 of the application. The TE-90 cover is a cover in accordance with the present invention. Thus, example balls 1, 2 and 3 of attached Table 2, which correspond to example balls 1, 2 and 3 of Table 8 of the application, are golf balls made in accordance with the present invention. Applicant submits that this demonstrative evidence establishes reduction to practice of the present invention in the United States prior to June 29, 1992.

In addition, it is also noted that examples 4 and 8 of attached Table 2 are represented as examples 4 and 5 of Table 8 in the application. Likewise, examples 6 and 8 of the attached Table 2 are shown as finished balls 6 and 7 of Table 9 (p. 46) of the instant application.

The Declaration under 37 C.F.R. §1.131 states that Michael J. Sullivan, the inventor, completed the invention of the present application, in this country, prior to June 29, 1992. In support thereof, the inventor has provided evidence of reduction to practice of the present invention as shown in the attached Tables 1 and 2. In view of the Declaration and evidentiary support included therewith, Applicant submits that the Proudfit U.S. Patent No. 5,314,187 no longer qualifies as "prior art" under 35 U.S.C. §103(a). As such, Applicant respectfully requests withdrawal of the rejection of claims 1-8 under 35 U.S.C. §103 over Proudfit ('187).

PROVISIONAL DOUBLE PATENTING REJECTIONS

Claims 1-6 have been provisionally rejected over claims 1-8 of copending U.S. Application No. 08/920,070. Additionally, claims 1-8 have been provisionally rejected over claims 1-6 of copending U.S. Application No. 08/870,585.

Applicant is of the opinion that the instant application's claims are not exactly the same as the claims of each of 08/920,070 and 08/970,585. However, upon indication of allowable subject matter, Applicant will provide a Terminal Disclaimer, if required and appropriate, to overcome the double patenting rejections.

At this time Applicant believes no Terminal Disclaimer is necessary as no allowable subject matter has been indicated in this or the copending applications.

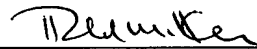
In addition, Applicant requests, should the present application now be in condition for allowability, that the Examiner withdraw the provisional obviousness type double patenting rejection and allow the present application to be allowed as per M.P.E.P. §804.

CONCLUSION

In view of the above comments, it is believed that this application is in condition for allowance. Therefore, the Applicant respectfully requests favorable reconsideration and the initiation of Interference proceedings with the Higuchi '852 patent. Should any issues remain, the Examiner is encouraged to contact the undersigned attorney in order to resolve any such issues.

Respectfully submitted,

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